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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/900,803
Filing Date: July 06, 2001
Appellant(s): YEN, BRIAN

MAILED

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GROUP 3600

Aaron Wininger (Registration No. 45,229)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09/04/2006 appealing from the Office action mailed

01/06/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20010051996   Cooper et al.   12-2001

Tyson, Jeff, "How the Old Napster Worked", How Stuff Works

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-4, 8, 10-19, 23, 25-35, 39-49, 51, 53-60, 62, 64-71, 73, 75-81 are rejected under

35 U.S.C. 103(a) as being unpatentable over "How the Old Napster Worked" by Jeff Tyson in

view of US Publication No. 2001/0051996 to Cooper et al.

Napster discloses receiving, from a first peer, a request for a data file, the request

including an ID (i.e. "user name") of the first peer, identifying a second peer having the data file

form an index of peers, sending, to the first peer, an address of the second peer (see page 2).

Napster does not expressly disclose processing payment for the data file or sending a first

encryption dataset to decrypt the data file. Cooper et al. disclose processing payment processing

payment for the data file (see paragraph [0184]), and sending a first encryption dataset to decrypt

the data file (see paragraph [0067]). At the time the invention was made, it would have been

obvious to a person of ordinary skill in the art to modify Napster to include the steps of

processing payment for the data file, sending a first encryption dataset to decrypt the data file.

One of ordinary skill in the art would have been motivated to do this because it prevents

unauthorized individuals from accessing the digital content thus reducing piracy.

Referring to claims 2 and 17, Napster discloses a second peer (see claims 1 and 16). Napster does not expressly disclose identifying a second peer geographically closest to the first peer. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the steps recited. The identifying a second peer having the data file from an index of peers step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983): in re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary sill in the art at the time the invention was made to identify a second peer in any location because such data does not functionally relate to the steps in the method claimed.

Referring to claims 3 and 18, Napster discloses a second peer (see claims 1 and 16). Napster does not expressly disclose identifying a second peer having a lowest number of pings in relation to the first peer. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the steps recited. The identifying a second peer having the data file from an index of peers step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983): in re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary sill in the art at the time the invention was made to identify a second peer of any type because such data does not functionally relate to the steps in the method claimed.

Referring to claims 4, 19, 35,49,60 and 71, Napster discloses the data file is a music file (see page 1).

Referring to claims 8, 23 and 39, Napster discloses a first and second peer (see claims 1 and 16 respectively above). Napster does not expressly disclose verifying a password from the first peer before processing payment and sending, to the first peer, the address of the second peer. Cooper et al. disclose verifying a password from the first peer before processing payment and sending, to the first peer, the address of the second peer (see paragraphs [0126] and [0130]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the step of verifying a password from the first peer before processing payment and sending, to the first peer, the address of the second peer. One of ordinary skill in the art would have been motivated it prevents unauthorized individuals from receiving the address of the second peer.

Referring to claims 10, 25 and 41, Although the "How the Old Napster Worked" does not explicitly indicate upon receipt, from the first peer, of a signal indicating inability to retrieve the data file, identifying another peer having the data file from an index of peers, sending, to the first peer an address of the another peer, this is a known processes of Napster. Napster, however, does not expressly disclose sending encryption dataset. Cooper et al. disclose sending an encryption dataset to decrypt the data file (see paragraph [0067]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Napster to include the step of sending a first encryption dataset to decrypt the data file. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from accessing the digital content thus reducing piracy.

Referring to claims 11, 26 and 42, Napster discloses a first peer (see claims 1 and 16).
Napster does not expressly disclose updating the index of peers to indicate that the first per
includes a copy of the data file. Cooper et al. disclose updating the index of peers to indicate that
the first per includes a copy of the data file (see paragraphs [0109] and [0098]). At the time the
invention was made, it would have been obvious to a person of ordinary skill in the art to modify
the method disclose by Napster to include the step of updating the index of peers to indicate that
the first per includes a copy of the data file. One of ordinary skill in the art would have been
motivated to do this because it monitors the peer's access/request of the data file.

Referring to claims 12, 27 and 44, Napster discloses a second peer (see claims 1 and 16
respectively above). Napster does not expressly disclose sending a second encryption dataset to
the second peer. Cooper et al. disclose sending a second encryption dataset to the second peer
(see paragraphs [005], [0067] and [0068]). At the time the invention was made, it would have
been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to
include the step of sending a second encryption dataset to the second peer. One of ordinary skill
in the art would have been motivated to do this because it provides additional data security.

Referring to claims 13, 28 and 45, Cooper et al. disclose the method wherein the second
encryption dataset includes an encrypted public transaction key and an encrypted public key, the
public key capable to encrypt data so that the encrypted data is decipherable only by the first
peer (see paragraphs [0067]).

Referring to claims 14, 29, 47, 55,66 and 77, Cooper et al. disclose the first encryption
dataset includes an encrypted private transaction key (see paragraphs [0067] & [0057]). At the
time the invention was made, it would have been obvious to a person of ordinary skill in the art

to modify the method disclose by Napster to include the first encryption dataset includes an

encrypted private transaction key. One of ordinary skill in the art would have been motivated to

do this because it provides data security and secures the data file.

Referring to claims 15, 30,56,67 and 78, Cooper et al. discloses the method wherein the

encrypted private transaction key is decipherable only by he first peer (see paragraph [0082]).

Referring to claim 16, Napster discloses receive, from a first peer, a request for a data

file, the request including an ID (i.e. "user name") of the first peer, identify a second peer having

the data file form an index of peers, sending, to the first peer, an address of the second peer (see

page 2). Napster does not expressly disclose process payment for the data file or send a first

encryption dataset to decrypt the data file. Cooper et al. disclose process payment processing

payment for the data file (see paragraph [0184]), and send a first encryption dataset to decrypt

the data file (see paragraph [0067]). At the time the invention was made, it would have been

obvious to a person of ordinary skill in the art to modify Napster to include the steps of process

payment for the data file, send a first encryption dataset to decrypt the data file. One of ordinary

skill in the art would have been motivated to do this because it prevents unauthorized individuals

from accessing the digital content thus reducing piracy.

Referring to claim 31, Napster discloses means for receiving, from a first peer, a request

for a data file, the request including an ID (i.e. "user name") of the first peer, means for

identifying a second peer having the data file form an index of peers, means for sending, to the

first peer, an address of the second peer (see page 2). Napster does not expressly disclose means

for processing payment for the data file or means for sending a first encryption dataset to decrypt

the data file. Cooper et al. disclose means for processing payment processing payment for the

data file (see paragraph [0184]), and means for sending a first encryption dataset to decrypt the

data file (see paragraph [0067]). At the time the invention was made, it would have been

obvious to a person of ordinary skill in the art to modify Napster to include means for processing

payment for the data file, and means for sending a first encryption dataset to decrypt the data file.

One of ordinary skill in the art would have been motivated to do this because it prevents

unauthorized individuals from accessing the digital content thus reducing piracy.

Referring to claim 32, Napster discloses a data file index capable to store listings of data

files, peers storing the data files, and encryption data needed to decrypt the data files; a

distribution engine, communicatively coupled to the index, capable to receive, from a first peer, a

request for a data file, the request including an ID (i.e. "user name") of the first peer, identify a

second peer having the data file form an index of peers, send, to the first peer, an address of the

second peer (see entire document). Napster does not expressly disclose a distribution engine

capable to process payment for the data file or send a first encryption dataset to decrypt the data

file. Cooper et al. disclose a distribution engine capable to process payment for the data file (see

paragraph [0184]), and send a first encryption dataset to decrypt the data file (see paragraph

[0067]). At the time the invention was made, it would have been obvious to a person of ordinary

skill in the art to modify Napster to include an engine capable of processing payment for the data

file, sending a first encryption dataset to decrypt the data file. One of ordinary skill in the art

would have been motivated to do this because it prevents unauthorized individuals from

accessing the digital content thus reducing piracy.

Referring to claim 33, Napster discloses a distribution engine (see claim 32 above).

Napster does not expressly disclose the engine identifies a second peer geographically closest to

the first peer. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the step recited. The identifying a second peer having the data file from an index of peers step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983*): In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary sill in the art at the time the invention was made to identify a second peer in any location because such data does not functionally relate to the steps in the method claimed.

Referring to claim 34, Napster discloses a distribution engine (see claim 32 above). Napster does not expressly disclose the engine is further identifies a second peer having a lowest number of pings in relation to the first peer. However, this difference is only found in the nonfunctional descriptive material and is not functionally involved in the steps recited. The identifying a second peer having the data file from an index of peers step would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983): in re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary sill in the art at the time the invention was made to identify a second peer of any type because such data does not functionally relate to the steps in the method claimed.

Referring to claim 48, Napster discloses receiving, from the server, an address of a second peer having the data file; sending, to the second peer, a download request for the data file; receiving, from the second peer, the data file and outputting the data file (see the entire

document). Napster does not expressly disclose sending, to a server, a purchase request for a

data file, the purchase request including a peer identifier or receiving form the server a first

encryption dataset for decrypting the data file. Cooper et al. disclose sending, to a server, a

purchase request for a data file, the purchase request including a peer identifier (see paragraph

[0184]), and receiving from the server a first encryption dataset for decrypting the data file (see

paragraph [0067]). At the time the invention was made, it would have been obvious to a person

of ordinary skill in the art to modify Napster to include the steps of sending, to a server, a

purchase request for a data file, the purchase request including a peer identifier or receiving form

the server a first encryption dataset for decrypting the data file. One of ordinary skill in the art

would have been motivated to do this because it prevents unauthorized individuals from

accessing the digital content thus reducing piracy.

Referring to claims 51 and 62, Napster discloses a first and second peer (see claim 1).

Napster does not expressly disclose sending a password to the server before receiving the address

of a second peer having the data file and the first encryption dataset for decrypting the data file.

Cooper et al. disclose sending a password to the server before receiving the address of a second

peer having the data file and the first encryption dataset for decrypting the data file (see

paragraphs [0126] and [0130]). At the time the invention was made, it would have been obvious

to a person of ordinary skill in the art to modify the method disclose by Napster to include the

step of sending a password to the server before receiving the address of a second peer having the

data file and the first encryption dataset for decrypting the data file. One of ordinary skill in the

art would have been motivated it prevents unauthorized individuals from receiving the address of

the second peer.

Referring to claims 53, 54,64,65,75 and 76, Although the "How the Old Napster

Worked" does not explicitly indicate a sending a signal indicating inability to download the data

file and receiving an address of a third peer having the data file after sending the signal

indicating inability to download the data file, this is a known processes of Napster.

Referring to claims 57 and 68, Cooper et al. disclose the decrypting the data file using the

private transaction key and a private key only known to the first peer (see [0082]).

Referring to claims 58,69 and 80, Cooper et al. disclose storing an encrypted copy of the

data file (see paragraph [0018], lines 12-15). As for notifying the server that the data file is

stored, this is an inherent step.

Referring to claim 59, Napster discloses receive, from the server, an address of a second

peer having the data file; send, to the second peer, a download request for the data file; receive,

from the second peer, the data file and output the data file (see the entire document). Napster

does not expressly disclose send, to a server, a purchase request for a data file, the purchase

request including a peer identifier or receive from the server a first encryption dataset for

decrypting the data file. Cooper et al. disclose send, to a server, a purchase request for a data file,

the purchase request including a peer identifier (see paragraph [0184]), and receive from the

server a first encryption dataset for decrypting the data file (see paragraph [0067]). At the time

the invention was made, it would have been obvious to a person of ordinary skill in the art to

modify Napster to include the steps of sending, to a server, a purchase request for a data file, the

purchase request including a peer identifier or receiving form the server a first encryption dataset

for decrypting the data file. One of ordinary skill in the art would have been motivated to do this

because it prevents unauthorized individuals from accessing the digital content thus reducing

piracy.

Referring to claim 70, Napster discloses a peer identification (i.e. "username") and an

engine capable to receive, from the server, an address of a second peer having the data file; send,

to the second peer, a download request for the data file; receive, from the second peer, the data

file and output the data file (see the entire document). Napster does not expressly disclose send,

to a server, a purchase request for a data file, the purchase request including a peer identifier,

receive from the server a first encryption dataset for decrypting the data file, decrypt the data file.

Cooper et al. disclose send, to a server, a purchase request for a data file, the purchase request

including a peer identifier (see paragraph [0184]), receive from the server a first encryption

dataset for decrypting the data file (see paragraph [0067]), and decrypt the data file with the first

encryption dataset (see paragraph [0060]). At the time the invention was made, it would have

been obvious to a person of ordinary skill in the art to modify Napster an engine capable to send,

to a server, a purchase request for a data file, the purchase request including a peer identifier,

receive from the server a first encryption dataset for decrypting the data file, and decrypt the data

file. One of ordinary skill in the art would have been motivated to do this because it prevents

unauthorized individuals from accessing the digital content thus reducing piracy.

Referring to claim 73, Napster discloses an engine (see entire document). Napster does

not expressly disclose send a password to the server before receiving the address of a second

peer having the data file and the first encryption dataset for decrypting the data file. Cooper et al.

disclose send a password to the server before receiving the address of a second peer having the

data file and the first encryption dataset for decrypting the data file (see paragraphs [0126] and

[0130]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the step of send a password to the server before receiving the address of a second peer having the data file and the first encryption dataset for decrypting the data file. One of ordinary skill in the art would have been motivated it prevents unauthorized individuals from receiving the address of the second peer.

Referring to claim 81, Napster discloses means for sending, to the second peer, a download request for the data file; means for receiving, from the second peer, the data file and means for outputting the data file (see the entire document). Napster does not expressly disclose means for sending, to a server, a purchase request for a data file, the purchase request including a peer identifier or receiving form the server a first encryption dataset for decrypting the data file. Cooper et al. disclose means for sending, to a server, a purchase request for a data file, the purchase request including a peer identifier (see paragraph [0184]), and means for receiving from the server a first encryption dataset for decrypting the data file (see paragraph [0067]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Napster to include means for sending, to a server, a purchase request for a data file, the purchase request including a peer identifier or receiving from the server a first encryption dataset for decrypting the data file. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from accessing the digital content thus reducing piracy.

3.   Claims 5-7, 9, 20-22, 24, 36, 50, 52, 61, 63, 72, 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over "How the Old Napster Worked" by Jeff Tyson in view of US

Publication No. 2001/0051996 and Cooper et al. as applied to claims 1, 16, 32, 48,59, 70 above, and further in view of US Publication No. 2002/011912 to Hunter et al.

Napster discloses a sending to the first peer data (see page 2). Napster does not expressly disclose selecting an advertisement to send to the first peer or sending to the first peer, an address, of a peer having the advertisement. Hunter et al. disclose selecting an advertisement to send to the first peer and sending, to the first peer, an address (i.e. URL link located on the top right corner of fig. 10) of a peer having the advertisement (see paragraphs [0086] and [0107], lines 11-13). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the steps of selecting an advertisement to send to the first peer or sending to the first peer, an address, of a peer having the advertisement. One of ordinary skill in the art would have been motivated to do this because it is an affected method for merchants to attract consumers.

Referring to claims 6, 21 and 37, Napster discloses a first peer (see claims 1, 20 & 36 above). Napster does not expressly disclose selecting an advertisement. Hunter discloses the selecting an advertisement is based on demographic data associated with the first peer (see paragraph [0082]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the step of selecting an advertisement is based on demographic data associated with the first peer. One of ordinary skill in the art would have been motivated to do this because provided an affected method for merchants to target consumers.

Referring to claims 7, 22 and 38, Napster discloses a peer (see claims 1, 20 & 36 above). Napster does not expressly disclose the processing payment processes a reduced payment for the

data file upon sending, to the first peer, the address of a peer having the advertisement. Hunter

discloses processing payment processes a reduced payment for the data file upon sending, to the

first peer, the address of a peer having the advertisement (*Hunter's invention "provides the*

ability to update music pricing at any time..."; *thereby, allowing consumers to receive pricing*

specials or incentives), see paragraph [0019]. At the time the invention was made, it would have

been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to

include the step of processing payment processes a reduced payment for the data file upon

sending, to the first peer, the address of a peer having the advertisement. One of ordinary skill in

the art would have been motivated to do this because encourages consumers to legally purchase

digital content.

Referring to claims 9 and 24, Napster discloses a first peer (see claim 1 above). Napster

does not expressly disclose the processing does not occur until receipt, from the first peer, of a

confirmation signal confirming receipt of the data file. Hunter et al. disclose the processing does

not occur until receipt, from the first peer, of a confirmation signal confirming receipt of the data

file (see paragraph [0060], lines 1-10). At the time the invention was made, it would have been

obvious to a person of ordinary skill in the art to modify the method disclose by Napster to

include the processing does not occur until receipt, from the first peer, of a confirmation signal

confirming receipt of the data file. One of ordinary skill in the art would have been motivated to

do this because it verifies that the first peer desires the file.

Referring to claims 20 and 36, Napster discloses a sending to the first peer data (see page

2). Napster does not expressly disclose select an advertisement to send to the first peer or send to

the first peer, an address, of a peer having the advertisement. Hunter et al. disclose select an

advertisement to send to the first peer and send to the first peer, an address (i.e. the URL link located on the top right corner of fig. 10), of a peer having the advertisement t (see paragraphs [0086] and [0107], lines 11-13). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Napster to include the instructions to select an advertisement to send to the first peer or send to the first peer, an address, of a peer having the advertisement. One of ordinary skill in the art would have been motivated to do this because provided an affected method for merchants to target consumers.

Referring to claim 50, Napster discloses a server (see claim 48 above). Napster does not expressly disclose receiving, from the server, an address of a peer having an advertisement and downloading, from the peer having the advertisement, the advertisement and playing the advertisement. Hunter et al. disclose receiving, from the server, an address (i.e. URL link to the page, located to on the top right corner of fig. 10) of a peer having an advertisement and downloading, from the peer having the advertisement, the advertisement and playing the advertisement (see paragraph [0086], see fig. 10). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Napster to include the steps of receiving, from the server, an address of a peer having an advertisement and downloading, from the peer having the advertisement, the advertisement and playing the advertisement. One of ordinary skill in the art would have been motivated to do this because provided an affected method of targeting consumers.

Referring to claims 52 and 63, Napster discloses the data file (see claims 48 and 59). Napster does not expressly disclose sending, to the server, a confirmation signal confirming receipt of the data file. Hunter et al. disclose sending, to the server, a confirmation signal

confirming receipt of the data file (see paragraph [0060], lines 1-10). At the time the invention

was made, it would have been obvious to a person of ordinary skill in the art to modify the

method disclose by Napster to include the step of sending, to the server, a confirmation signal

confirming receipt of the data file. One of ordinary skill in the art would have been motivated to

do this because it verifies that the first peer desires the file.

Referring to claim 61, Napster discloses a server (see claim 48 above). Napster does not

expressly disclose receive, from the server, an address of a peer having an advertisement and

download, from the peer having the advertisement, the advertisement and play the advertisement.

Hunter et al. disclose receive, from the server, an address (i.e. URL link to the page, located to

on the top right corner of fig. 10) of a peer having an advertisement and download, from the peer

having the advertisement, the advertisement and play the advertisement (see paragraph [0086],

see fig. 10). At the time the invention was made, it would have been obvious to a person of

ordinary skill in the art to modify the method disclose by Napster to include instructions to

receive, from the server, an address of a peer having an advertisement and download, from the

peer having the advertisement, the advertisement and playing the advertisement. One of

ordinary skill in the art would have been motivated to do this because provided an affected

method of targeting consumers.

Referring to claim 72, Napster discloses a server (see claim 48 above). Napster does not

expressly disclose receive, from the server, an address of a peer having an advertisement and

download, from the peer having the advertisement, the advertisement and play the advertisement.

Hunter et al. disclose receive, from the server, an address (i.e. URL link to the page, located to

on the top right corner of fig. 10) of a peer having an advertisement and download, from the peer

having the advertisement, the advertisement and play the advertisement (see paragraph [0086],

see fig. 10). At the time the invention was made, it would have been obvious to a person of

ordinary skill in the art to modify the engine disclose by Napster to receive, from the server, an

address of a peer having an advertisement and download, from the peer having the

advertisement, the advertisement and play the advertisement. One of ordinary skill in the art

would have been motivated to do this because provided an affected method of targeting

consumers.

Referring to claim 74, Napster discloses the data file (see claim 70 above). Napster does

not expressly disclose send, to the server, a confirmation signal confirming receipt of the data

file. Hunter et al. disclose send, to the server, a confirmation signal confirming receipt of the

data file (see paragraph [0060], lines 1-10). At the time the invention was made, it would have

been obvious to a person of ordinary skill in the art to modify the engine disclose by Napster to

send, to the server, a confirmation signal confirming receipt of the data file. One of ordinary

skill in the art would have been motivated to do this because it verifies that the first peer desires

the file.

(10) Response to Argument

(I) 35 USC § 101 rejection of claims 1 and 16.

The 35 USC § 101 rejection of claims 1 and 16 has been withdrawn.

(II) 35 USC § 103 (a) over Tyson and Cooper

Appellant argues that "it would not have been obvious to combine the references as no

one has done so since the failure of Napster due to a lack of digital rights management

component." Appellant also asserts that "Napster ceased their P2P file sharing system because of copyright violations and the inability to combine a P2P system with a digital rights management system." Appellant further argues that "Napster's P2P system was in effect a failed experiment and is therefore unavailable as prior art".

Napster, the primary reference, teaches the P2P system and all of Appellant's limitations except processing payment for the data file and sending a first encryption dataset to decrypt the data. Although the "Old Napster" is no longer in existence, the overall concept is old and well known. Thus, modifying the "Old Napster" by including a payment component is also feasible. One of ordinary skill in the art would have been motivated to do this because it prevents unauthorized individuals from accessing the digital content thus reducing piracy.

The fact that "Napster ceased their P2P file sharing system because of copyright violations" does not make it inoperable; the system was functioning and operable, but was disabled for legal issues.

Appellant argues that the history of Napster teaches away from incorporating a digital rights management system because the failure of Napster to do so and to instead reinvent itself as a conventional file downloading service.

"A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. Thus, the question whether a reference 'teaches away' from the invention is inapplicable to an anticipation analysis." *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 58 USPQ2d 1508, 1514 (Fed. Cir. 2001) citing *Celeritas Techs. Ltd. V. Rockwell Int'l Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998).

Appellant agues that there is no motivation to combine the cited references.

In response to applicant's argument that there is no suggestion to combine the references,

the examiner recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). In this case, both Tyson and Cooper et al. teach a content distribution system and are

analogous art. Although Tyson does not expressly disclose processing payment for data file and

sending a first encryption dataset to decrypt the data file, Cooper et al. overcomes these

deficiencies. Therefore, it is proper to combine Tyson and Cooper et al., one of ordinary skill in

the art would have been motivated to do this because it prevents unauthorized individuals from

accessing the digital content thus reducing piracy.

As for claims 2, 3, 17, 18, 33, and 34 Appellant fails to provide arguments.

Claim 1	Tyson- "How the Old Napster Worked"	Cooper- US Publication No. 2001/0051996
receiving, from a first peer, a request for a data file,	First peer = user ("you") Data file = songs If it found a connection, Napster logged you on to the server. You typed in the title or artist of the song you were looking for (see page 2)	
the request including an ID of the first peer	Napster logged you on to the server. The main purpose of this central server was to keep an index of all the Napster users currently	

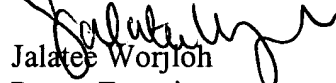|		
	online (see page 2). *Note, the user logs-in, which is known to include a user name/ID of the first peer*	
identifying a second peer having the data file from an index of peers	Second peer – other Napster computers The Napster utility on your computer queried the index server for other Napster computers online that had the song you requested. (see page 2).	
processing payment for the data file and		Data file = content When a consumer decides to purchase and download content, that consumer places an order with the content distribution system or one of a plurality of customer sites (see paragraph [0184]).
sending, to the first peer, an address of the second peer	Whenever a match was found, the Napster server informed your computer where to find the requested file (see page 2).	
sending…. a first encryption dataset to decrypt the data file		Encryption dataset = private key Issue encryption key pair to the consumer's device gateway or use existing public/private key pair for this user/certificate (see paragraph [0067).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related

Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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